

## REMARKS

Claims 1-20 and 23-100 are pending in the application.

The specification has been amended to remove the phrase "other means" from the paragraph at page 8, line 19, to page 9, line 2 and to correct an obvious typographical error in this paragraph. Accordingly, no new matter has been added by this amendment.

**Applicant again respectfully requests that the Examiner initial and return a copy of the PTO Form 1449 submitted with the Supplemental Information Disclosure Statement filed September 30, 2004.**

**Also, Applicant again notes that there were four pages of material attached to the Office Action dated December 23, 2004 that do not appear to relate to the instant application. These papers appear to relate to a German language document DE 43 18 692 A1. As clarification has not been provided in response to Applicant's request regarding whether these papers were erroneously attached to the Office Action, Applicant assumes that these papers were erroneously attached to the Office Action and are not related to the instant application.**

The remaining outstanding rejections are addressed below.

- 1. Obviousness-type double patenting rejection of claims 12-20, 39-43, 50, 53, 56, and 73-85 has been overcome.**

Claims 12-20, 39-43, 50, 53, 56, and 73-85 were rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-23 of U.S. Patent No. 5,969,117 in view of U.S. Patent No. 5,271,941, Prewett *et al.* (1996), and U.S. Patent No. 5,658,947.

Although Applicant does not acquiesce in the rejection or the characterization of the cited references, in order to expedite prosecution Applicant encloses herewith a terminal disclaimer over U.S. Patent No. 5,969,117.

In view of this submission, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

**2. Rejection under 35 U.S.C. § 112, second paragraph has been overcome.**

Claims 1-20 and 23-100 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office Action states that the term "complementary" in claims 1-20 and 23-100 is indefinite because the specification does not clearly redefine the term. (Office Action, page 5) Applicant respectfully disagrees.

The Office Action opines that "complementary" in claims 1-20 and 23-100 means "binding by any other means," while the accepted meaning is "binding by means of hydrogen binding." Applicant disagrees with this assessment. As stated in the specification, "the terms 'oligonucleotide sequence that is complementary to a genomic region or an RNA molecule transcribed therefrom' and 'oligonucleotide complementary to' are intended to mean an oligonucleotide that binds to the target nucleic acid sequence under physiological conditions, e.g., by Watson-Crick base pairing (interaction between oligonucleotide and single-stranded nucleic acid) or by Hoogsteen base pairing (interaction between oligonucleotide and double-stranded nucleic acid) or by any other means including in the case of a oligonucleotide binding to RNA, causing pseudoknot formation. Binding by Watson-Crick or Hoogsteen base pairing under physiological conditions is measured as a practical matter by observing interference with the function of the nucleic acid sequence." (Specification, page 8, line 19 to page 9, line 2.) Thus, the claim term defined is not "complementary," and this term is not defined to mean only "binding by any other means."

Applicant does not acquiesce to the determination that the specification does not clearly redefine the term. Nor does Applicant acquiesce to the Office Action's statement of the accepted meaning of the term. However, in order to expedite prosecution,

Appl. No. 09/412,947  
Amdt. dated October 11, 2005  
Reply to Office Action of July 11, 2005

Applicant has amended the paragraph in the specification to remove the phrase "any other."

Accordingly, Applicant respectfully requests that this rejection be reconsidered and withdrawn.

### CONCLUSIONS

In view of the arguments set forth above, Applicant respectfully submits that the rejections contained in the Office Action mailed on July 11, 2005, have been overcome, and that the claims are in condition for allowance. It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with, or concession of, that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, unless specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

If the Examiner believes that any further discussion of this communication would be helpful, she is invited to contact the undersigned at the telephone number provided below.

Enclosed herewith is a terminal disclaimer. Please charge the \$65.00 fee (small entity) for this terminal disclaimer to our Deposit Account No. 08-0219. No other fees are believed to be due in connection with this response. However, please charge any underpayments or credit any overpayments to Deposit Account No. 08-0219.

Respectfully submitted,

Handwritten signature of Ann-Louise Kerner, Ph.D., with the text "Reg. #52,770 for" written next to it.

Ann-Louise Kerner, Ph.D.  
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